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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/355,601	07/30/1999	David J. Kinning	54545USA6A	6681

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EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/355,601

Applicant(s)

Kinning et al

Examiner

T. Yoon

Group Art Unit

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— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 3-11-03

☒ This action is **FINAL**

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-3, 5-15, 18-20, 26-28, 31-35 and 38 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3, 5-15, 18-20, 26-28, 31-35 and 38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is redundant, and claim 20 improperly broadens the scope of claim 1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-15, 19, 20, 31 and 38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bartizal (US 3,796,678).

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Bartizal teaches pressure sensitive adhesives (PSA) comprising polyurethane, polyurethane-polyurea or polyurea at col. 2, lines 49-54, cols. 6-7 and in examples. The formula (IX) with substituents meets the instant formula. The instantly recited proeperties are inherent in the PSA of Bartizal.

Thus, the isntant invention lacks novelty.

Claims 1, 5-15, 18-20, 31 and 38 are rejected under 35 U.S.C. 103(a) as obvious over Bartizal (US 3,796,678) and WO 98/13135 or Kesti et al (US 5,824,748).

The instant invention further recites an acid-containing polymer. However, pressure sensitive adhesive compositions comprising such polymer are well known as taught by WO and Kesti et al (examples).

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize an acid-containing polymer of WO or Kesti et al in Bartizal since Bartizal teaches employing active -H containing materials at col. 10, lines 55-57.

Claims 1-3, 5-15, 19, 20, 26-28, 31-34 and 38 are rejected under 35 U.S.C. 103(a) as obvious over Bartizal (US 3,796,678) and WO 96/35458.

The instant invention further recites a tackifier, tapes, release coating, polyurea backing and an extrusion reaction of polyamines and polyisocyanates over Bartizal.

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WO teaches pressure sensitive adhesive compositions, process of making thereof and applications at lines 20-21 of page 5 (hot melt, PSA), abstract, lines 5-15 and 26-31 of page 6 and pages 25 -30 (various substrates, tapes, release coating) and lines 13-16 of page 8 and lines 7-22 of page 21 (extrusion reaction of polyamines and polyisocyanates). Polyurea backing is taught at line 1 of page 28. Tables 1-5 show the instant peel strength and shear strength.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize a tackifier of WO in Bartizal since Bartizal teaches employing other additives such as other adhesives at col. 10, lines 51-57, and further to utilize the process of WO in Bartizal to make PSA tapes since the use of the known PSA compositions comprising polyurea-based component in making such PSA tapes is considered a *prima facie* obviousness absent showing otherwise.

Claims 1-3, 5-15, 19, 20, 26-28, 31-35 and 38 are rejected under 35 U.S.C. 103(a) as obvious over Bartizal (US 3,796,678) and WO 96/35458, and further in view of Wright et al (US 6,224,949).

The instant invention further recites polymerization on the web over Bartizal and WO. However, such method in making PSA tapes is a routine practice as taught by Wright et al, col. 11, lines 32-53 and col. 18, line 40.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to further polymerize said PSA composition of Bartizal on the web taught by Wright et

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al since the use of the known PSA compositions comprising polyurea-based component in making such PSA tapes is well known as taught by WO and since the use of known method of making PSA tapes taught by Wright et al in Bartizal and WO thereof is considered a *prima facie* obviousness absent showing otherwise.

Claims 1, 9-15, 19, 20, 26, 28, 31, 34 and 38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Trancik (US 3,896,789).

Trancik teaches pressure sensitive adhesives (PSA) and a tape thereof comprising polyurethane, polyurethane-polyurea or polyurea at col. 2, lines 48-54. The example 1 shows a step of solvent coating the PSA on a substrate and a silicone release paper. Releases liner is also taught at col. 5, lines 9-18.

Thus, the instant invention lacks novelty.

Claims 1-3, 5-15, 19, 20, 26-28, 31-34 and 38 are rejected under 35 U.S.C. 103(a) as obvious over Trancik (US 3,896,789) and WO 96/35458.

The instant invention further recites a tackifier, polyurea backing and an extrusion reaction of polyamines and polyisocyanates over Trancik.

WO teaches pressure sensitive adhesive compositions, process of making thereof and applications at lines 20-21 of page 5 (hot melt, PSA), abstract, lines 5-15 and 26-31 of page 6 and

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pages 25 -30 (various substrates, tapes, release coating) and lines 13-16 of page 8 and lines 7-22 of page 21 (extrusion reaction of polyamines and polyisocyanates). Poyurea backing is taught at ine 1 of page 28. Tables 1-5 show the instant peel strength and sheat strength. WO teaches pressure sensitive adhesive compositions, Poyurea backing is taught at ine 1 of page 28. Tables 1-5 show the instant peel strength and sheat strength.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize a tackifier of WO in Trancik since Trancik teaches employing other additives at col. 5, lines 9-11, and further to utilize the process of WO in Trancik to make PSA tapes since the use of the known PSA compositions comprising polyurea-based component in making such PSA tapes is considered a *prima facie* obviousness absent showing otherwise.

Claims 1-3, 9-15, 19, 20, 26, 31, 32, 34 and 38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hassel et al (US 5,047,272) or Starzewski et al (US 5,049,427).

The instant rejection is maintained for reason of record and following.

The claim 20 also recites a heat-activatable adhesive and thus the recited pressure sensitive adhesive in claim 1 has little probative value. Note that a tackifier is an optionl component in claim 1, and thus the polyurea-based adhesive of Hassel et al and Starzewski et al meets the instant invention.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/April 17, 2003



TAE H. YOON
PRIMARY EXAMINER